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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 10/038,004
Filing Date: January 02, 2002
Appellant(s): BAUM, DANIEL R.

Bao Tran

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed with a Certificate of Mailing dated July 1, 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

The amendment, paper # 6, after final rejection filed on February 05, 2003 has been entered. An advisory action, paper#7, was mailed on February 24, 2003 and the same is received and acknowledged by the Applicant. In the advisory action, rejection of claim 21 under 35 USC 112, first paragraph was withdrawn (see box 3) and it was indicated that the proposed amendments in the amendment after final, paper #6, would be entered for purposes of Appeal (see box 7).

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-21 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,324,521	Shiota et al.	11-2001
6,092,054	Tackbary et al.	7-2000

Note: Shiota et al. and Tackbary et al. are referred to as Shiota and Tackbary, hereinafter.

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(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. The ground (s) for rejection are reproduced below from the final Office Action and are provided here for the convenience of both Appellant and The Board of Patent Appeals:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5-12, 14, 16, and 21 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Shiota et al. (US Patent 6,324,521)

With regards to claims 1 and 21, Shiota teaches a computer-implemented method of distributing cards to a plurality of recipients, the method comprising:

Receiving a card order specifying a plurality of recipients and, for each specified recipient, a set of one or more uploaded images associated with that recipient (col.10, line 33-col.11, line 21. Note, Here, Shiota teaches that the center server receives an order from the customer (personal computer 6) which includes uploaded image data for the prints ordered for recipients. The orders include postcards (col.3, lines 31-35) and picture postcards (col.4, lines 28-32) which correspond to a card order in the application. Col.11, line 38-col.12, line 24 discloses that there are plurality of recipients (customer and his/her friend). Also see Fig.1 (6-PC correspond to plurality of recipients)

For each of the plurality of recipients specified in the received card order, printing at least one card having at least one uploaded image from the recipient's image set and distributing the printed cards having the recipients' uploaded images to their respective associated recipients (col.11, lines 38-col.12, line 24. Customer and his friend are the plurality of recipients and prints (which could be photograph/postcards/picture postcards as disclosed in col.3, lines 31-35 and col.4, lines 28-32) with uploaded images are distributed to customer and to the customer's friend).

With regards to claims 3 and 10, Shiota discloses that image set differ from one recipient to second recipient and also dividing the received card order into a plurality of sub-card orders, each sub-card order corresponding to a different recipient (col.11, lines 38-col.12, line 24. Note:

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picture a for the customer and picture b for the friend. Pictures a and b could be different and can be ordered by customer and friend separately via Internet).

With regards to claims 5-8, Shiota teaches that a user from a digital camera (col. 2, lines 34-42 uploads the images. a picture image obtained from a memory or the like of a digital camera ") to a printing service (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10), receiving, printing and distributing is dispersed among two or different entities (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10. Note: laboratory server and center server are tow or different entities) or can be performed by a single entity (col.1, lines 29-38, "...However, it is preferable to have only one wholesale labdata management ").

With regards to claim 9, Shiota teaches receiving orders for picture postcard by an enterprise providing a web front-end (See. Figs.1 and 6. Also see col.10, lines 30-41).

With regards to claims 11-12, Shiota teaches that card order comprises a single transaction and is terminated by a click of a "card order" button (col.8, lines 17-30, "...can request a printing service without going to the minilab 3 by carrying out a predetermined input on an order screen through confirmation of the thumbnail image.....". Note: thumbnail image corresponds to "card-order" button and confirmation of thumbnail image corresponds to a single sequence transaction)

With regards to system claims 14, and 16, all of their limitations are similar to the limitations of method claims 1, 7, and 11-12 analyzed above and are rejected similarly.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al. and further in view of Tackbary et al. (US Patent 6,092,054).

With regards to claims 2, 4 and 15, Shiota teaches a computer-implemented method and system of distributing cards to a plurality of recipients, as disclosed in claims 1 and 14 above. Shiota further teaches printing of postcards and picture and postcards (col.3, lines 31-35, and col.4, lines 27-31) and cards could differ in size, copies, finish (col.3, lines 31-45, "...postcard generation....size of the print, and the number of the print..."). Shiota does not disclose printing a greeting card and a playing card with textual message. However, Tackbary teaches printing a greeting card and a playing card with textual message which are grouped under "social expression cards " (at least see, col.1, line 19-col.2, line 46, "...The invention relates... ordering, and delivering social expression cards.....upon receiving an order, to select designated cards.... print the buyer's messages on the cards, and send the cards to the buyer or the recipients"). In view of Tackbary, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Shiota to include the feature of printing and

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distributing greeting card, playing card or other social expression cards along with picture postcard with textual message. Doing so would allow the customer in Shiota to modify the picture postcards to social expression cards, like greeting cards or playing cards, with textual messages and send them on occasions like birthdays/anniversary, etc. and thereby eliminating the need to spend time and effort in buying them from another source.

Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al.

With regards to claim 13, Shiota teaches a computer implemented method of distributing cards to a plurality of recipients, as disclosed in claim 1 above. Shiota further teaches payment method (Fig.2). Shiota does not disclose charging to one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. However, it is a generally known information that while shopping/placing orders via Internet/WWW payment is made via one of the many notoriously known means of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. Therefore, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to charge, in Shiota, via one of the many notoriously known means of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon.

Claims 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shiota et al., and further in view of Tackbary et al. (US Patent 6,092,054).

With regards to claims 17, Shiota (col.1, line 56-col.12, line 24) teaches all the limitations of the claims. Shiota does not teach obtaining message data from the user specifying message content to be included in the print communications and including this message data in the print communications. However, Tackbary obtaining message data from the user specifying message content to be included in the print communications and including this message data in the print communications (at least see, col.1, line 19-col.2, line 46, "...The invention relates... ordering, and delivering social expression cards.....upon receiving an order, to select designated cards....print the buyer's messages on the cards, and send the cards to the buyer or the recipients"). In view of Tackbary, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Shiota to include the feature of obtaining message data from the user specifying message content to be included in the print communications and including this message data in the print communications. Doing so would allow the customer in Shiota to modify the picture postcards to include the message content in the print communications to use them as social expression cards, like greeting cards/anniversary cards, etc. thereby eliminating the need to spend time and effort in buying social expression cards, like greeting cards, from another source.

With regards to claims 18-20, Shiota/Tackbary teaches uploading images from a digital camera or a data storage (col. 2, lines 34-42, "...a picture image obtained from a memory or the like of a digital camera". Note: memory corresponds to a data storage device) and uploading to a printing device (at least see, Fig.6. Center Server is the printing service. Also see col.10, line 30-col.11, line 21 and col.1, line 56-col.2, line 10).

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(11) Response to Argument

ISSUE I. Whether claims 1, 3, 5-12, 14, 16 and 21 are anticipated by Shiota et al. under 35 U.S.C. 102 (e).

Appellant remarks on page 4 of the brief, " Shiota does not show the specifics of a single order that specifies multiple recipients", at page 5, " Second, although Shiota's Fig.1 shows a plurality of PCs, there is no showing that each PC can issue a single card order that specifies a plurality of recipients ", and " Shiota discusses an example showing that multiple prints may be ordered. However, the discussion below is silent on whether the customer can order for all recipients at once or one recipient at a time ".

The Examiner notes that the claims 1, 3, 5-12, 14, 16 and 21 neither recite that the card order received is "single" nor they recite that the customer can order for all recipients at once or one recipient at a time. Claims 1, 3, 5-12, 14, 16 and 21 merely recite "receiving a card order specifying a plurality of recipients ". Shiota clearly teaches this claimed limitation of placing and receiving an order for a plurality of recipients, which include himself and a friend of his (col.11, lines 54-61). The examiner also notes that the Appellant has acknowledged this teaching of Shiota (see page 5 of the brief "Shiota discusses an example showing that multiple prints may be ordered ").

Appellant remarks on page 5 of the brief, " Because Shiota's Fig.2 shows one recipient designation at a time , the only logical conclusion one can reach is that at one sitting, the user must individually enter a separate order for each recipient ".

The Examiner observes, as mentioned above, that claims 1, 3, 5-12, 14, 16 and 21 do not recite that an order is placed "at one sitting ". Claims 1, 3, 5-12, 14, 16 and 21 merely recite

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"receiving a card order specifying a plurality of recipients ". In Shiota, Fig.2 is a mere example of the flow of order information (see at least col.6, line 46). Shiota, as stated earlier, explicitly shows placing and receiving an order for a plurality of recipients, which include himself and a friend of his (col.11, lines 54-61).

Appellant remarks on page 7 of the brief, " Shiota does not show the user-uploaded aspect. This is another reason for traversing the section 102 Rejection ", " However, Shiota does not show that a user directly uploaded images. Hence Shiota does not have the user – uploaded aspect as claimed ", and on page 8 of the brief, " With regard to claims 5-6, Shiota shows that a print service uploads images scanned from film. However, there is no teaching in Shiota that a user directly uploads the images ".

The Examiner observes that the claims 1, 3, 5-12, 14, 16 and 21 do not recite the term " user directly uploaded images" , instead they recite "user- uploaded images". The Examiner acknowledges that Shiota teaches scanning films from a film roll but does not agree with the Appellant's remarks that Shiota does not disclose " user-uploaded images". Shiota discloses uploading images from a memory or from a digital camera brought in the laboratory by a user using a variety of data transferring means (see at least col.2, lines 36-40). Laboratory is equipped with a laboratory server with a communication ability via a network (see col.1, lines 62-65, see FIG.1, "3" and "4". MiniLab 3 and Special Laboratory 4 are connected to the users via Internet.). Transferring images from a memory or from a digital camera (digital camera inherently includes a memory for storing the images) to the Laboratory server by data transferring means corresponds to uploading images from the user. Shiota further discloses uploading order files, which include images (FIG.6, see the box "Order File Upload ", col.10, lines 41-47 and col.11, lines 13-21, "...The WWW application server 36 receives the order file

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20 uploaded by the user ". This order file includes the images that are ordered for printing by the printing service server).

Appellant remarks on page 8 of the brief regarding claims 3 and 7-8 that since two elements are missing in Shiota, Shiota cannot anticipate the dependent claims 3 and 7-8 and they should be allowable, the Examiner does not agree since the two said elements are disclosed by Shiota, as analyzed above. Therefore, Shiota anticipates the dependent claims 3, 7-8, and 10 as described on pages 8 of the final action.

Appellant remarks on page 8 of the brief, " claim 4 cannot be anticipated since Shiota does not show the specifics of print parameters that include one or more print size, number of copies, print finish, and/or a textual message for the printed cards".

The Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the rejection as it applies to claim 4 is based on a combination of teachings of Shiota and Tackbary. Shiota is not relied upon solely.

The Examiner has identified that Shiota discloses using the print parameters which include the size of the print, number of copies of the prints and print finish by stating to generate a postcard (FIG.2, col.3, lines 31-35 and col.8, lines 31-47). Shiota further discloses that print parameters include if the ordered items are to be arranged in album or mounted on a photograph mount (col.4, lines 28-42). The Examiner further identified on pages 9-10 of the final action that Shiota does not teach printing textual messages on the printed cards. The Examiner has not relied on Shiota alone, but rather in combination with Tackbary to provide

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motivation for the skilled person in the art to have incorporated the feature of printing different textual messages on the postcards in Shiota based upon different occasions like birthdays/anniversary to different recipients.

With regards to the Applicant's remarks on page 9 of the brief that Shiota does not show the web front-end for a user to upload images and thus claim 9 is allowable over Shiota, the Examiner does not agree. Shiota discloses a web front-end for a user to upload images (see FIG.6, box labeled " order file upload" on the customer's personal computer, 6 and the box labeled "order file reception " on the Central server, 12. The uploaded order includes the uploaded images as well.).

With regards to the Applicant's remarks on page 9 of the brief, regarding claims 11-12 that Shiota is silent on whether the card order comprises a single transaction sequence and a single transaction sequence is terminated by a click of a card order button, the Examiner does not agree as Shiota anticipates these limitations (see col.8, lines 17-30) and as analyzed on the page 8 of the final action.

With regards to the Applicant's remarks on page 9 of the brief, regarding claims 14 and 16, that Shiota does not anticipate them, the Examiner does not agree. Shiota shows a computer-implemented method including a front-end computer subsystem for ordering cards and for receiving a card order (see at least FIG.6. FIG>6 shows a customer's personal computer, 6, and a Center Server, 12. Center Server 12 corresponds to the front-end computer subsystem for receiving a card order-see the boxes labeled "order file upload" and "order file

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reception"). All other limitations of the claims 14 and 16 are parallel to the limitations of claims 1, 3, 5-12 and are therefore analyzed and rejected based upon the same rationale.

With regards to the Applicant's remarks on page 9 of the brief, regarding claim 21, that Shiota does not show at least receiving a card order from an orderer, such order specifying a plurality of recipients where at least one of the specified recipients is different from the orderer and, for each specified recipient, a set of one or more user-uploaded images associated with that recipient, the Examiner does not agree. Shiota shows receiving order specifying a plurality of recipients such that at least one of the specified recipient is different from the orderer (see col, 11, lines 54-67. The orderer orders for himself and his friend). All the other limitations are parallel to claim 1 and are therefore analyzed and rejected based upon the same rationale.

Issue II. Whether claim 13 is unpatentable under Section 103 (a) over Shiota et al.

The Applicant remarks on pages 9-10 of the brief, regarding claim 13, that Shiota does not show the specifics of claim 13 when viewed with the language of the parent claim 1 and the elements of claim 1 and that there is no motivation to produce the claimed invention of claim 13.

The Examiner disagrees with the Appellant's remarks as it has been already analyzed and demonstrated above that Shiota anticipates claim 1. The Examiner acknowledges that Shiota does not disclose charging to one or more of a credit card, a debit card, electronic funds transfer, a gift certificate, or a coupon. The Examiner has not relied on Shiota alone, but rather in combination with the notoriously well-known concept to provide motivation for one skilled in the art to have incorporated the concept of charging a credit cards/debit cards as a means of payment to complete the transaction, see page 10 of the final action.

Issue III. Whether claims 2, 4, 15 and 17-20 are unpatentable under Section 103
(a) over Shiota and Tackbary (USPN 6,092,054).

The Appellant remarks on page 11 and 12 that Tackbary relies on pre-designed cards that are digitized and stored in a database that the user can't upload and teaches away from the invention and that there is no motivation or suggestion to combine Shiota and Tackbary.

The Examiner notes that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the rejection as it applies to claims 2, 4 15 and 17-20 is based on a combination of teachings of Shiota and Tackbary. Shiota or Tackbary is not relied upon individually.

The Examiner has identified on page 9 of the final action that Shiota discloses all the limitations of independent claims 1 and 14 on which claims 2, 4 and 15 depend, as analyzed in the final action and above. Shiota further teaches printing of picture and postcards (col.3, lines 31-35, col.4, lines 27-31) and cards could differ in sizes, copies, finish (FIG.2, col.3, lines 31-35 and col.8, lines 31-47). Shiota further discloses that print parameters include if the ordered items are to be arranged in album or mounted on a photograph mount (col.4, lines 28-42).

The Examiner further identified on pages 9-10 of the final action that Shiota does not teach printing a greeting card or postcard with textual messages on the printed cards. The Examiner has not relied on Shiota alone, but rather in combination with Tackbary to provide motivation for the skilled person in the art to have incorporated the feature of printing postcards

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and greeting cards with different textual messages on the postcards in Shiota based upon different occasions like birthdays/anniversary to different recipients.

The Examiner has identified on page 10 of the final action that Shiota teaches the following limitations of claim 17: uploading image data from the user specifying an appearance of the print (see FIG.6, col.10, line 42-col.11, line 21. Note: uploading of order file from the user's computer 6 to the central server 12. Order file includes the images to be printed.), obtaining address information from the user specifying names and addresses of the one or more recipients, producing the print communications incorporating the uploaded image data and distributing the print communications to the one or more recipients in accordance with instructions provided by the user (FIGs.2, 3, 4 and 6, col4, lines 27-54, col.8, lines 31-38, col.10, line 41-col.12, line 24).


The Examiner has identified on pages 9-10 of the final action that Shiota does not teach the element of obtaining message data from the user specifying message content to be included in the print communication and including this message data in the print communications. The Examiner has not relied on Shiota alone, but rather in combination with Tackbary to provide motivation for the skilled person in the art to have incorporated the feature of the element of obtaining message data from the user specifying message content to be included in the print communication and including this message data in the print communications.

The Examiner has further identified on page 11 of the final action that Shiota teaches all the limitations of claims 18-20.

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Jeffrey A. Smith
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August 21, 2003

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